

Applicants, however, respectfully submit that the rejection under 112, second paragraph is improper.

As an initial consideration, the Examiner's reasoning does not apply to claim 17, because it defines a component of the claimed material in terms of two properties. Specifically, claim 17 provides for "[a]n improved cathode material comprising EMD having an AA-cell discharge capacity at a 1 watt discharge rate of about 68.2 milliampere hours per gram or higher and an AA-cell discharge energy at a 1 watt discharge rate of about 755 milliwatt hours or higher."

More importantly, Ex parte Spacht does not support the proposition that claims defining a material in terms of a single property are indefinite per se. In that case, the rejected claim provided for "[a] composition comprising an organic material normally susceptible to oxidation . . ." The board of appeals rejected the claim as failing to comply with the requirements of § 112 "since it is unduly broad and indefinite and based upon an insufficient disclosure." In upholding the rejection, the board found that "the term 'oxidation' is not limited to the air oxidation apparently intended in the specification, but broadly includes the increase in valence of an element." The board reasoned that "[t]here are many diverse mechanisms for oxidation" but that [t]he specification appears to be limited to a disclosure of the oxidation of conjugated diene rubbersm olefinic gasolines, and similar materials." Ultimately, the board concluded that "appellant's disclosure is entirely inadequate to support the tremendously speculatively broad claim terminology." Id. at 410. Thus, the rejected claim was not indefinite because it defined a composition in terms of a single property, but rather because that property included mechanisms not supported by the specification.

The second paragraph of 35 U.S.C. 112 "requires only that claims set out and circumscribe a particular area with a reasonable degree of precision and particularity." In re

Miller, 169 U.S.P.Q. 597, 599 (C.C.P.A 1971). The court in In re Miller concluded that there is no merit in any proposition "which would require the denial of the claim *solely* because of the *type* of language used to define the subject matter for which patent protection is sought." Id. (emphasis in original). Accordingly, a claim describing a material in terms of a single property is not indefinite per se under § 112. Here, the skilled artisan would comprehend with a reasonably degree of precision and particularity the scope of the claimed invention. Therefore, the rejection of claims 17-25 is improper and should be withdrawn.

CONCLUSION

For the foregoing reasons, Applicants submit that the rejection under 35 U.S.C. 112, second paragraph is improper. Claims 17-25 are in condition for allowance, and such action is respectfully requested.

This is intended to be a complete response to the Office Action mailed August 28, 2001.

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington D.C. 20231, on October 24, 2001.

Dana M. Coots

Dana M. Coots

Date: October 24, 2001

Respectfully submitted,

C. Clark Dougherty Jr.

C. Clark Dougherty, Jr.

Registration No. 24,208

McAFEE & TAFT

Tenth Floor, Two Leadership Square

211 North Robinson

Oklahoma City, Oklahoma 73102

(405) 235-9621

Attorney for Applicants